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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,826

10/28/2005

Oystein Ljungmann

027064-004

8640

21839 7590 01/26/2009  
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EXAMINER

LEVKOVICH, NATALIA A

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

01/26/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/537,826	<b>Applicant(s)</b> LJUNGMANN ET AL.	
	<b>Examiner</b> NATALIA LEVKOVICH	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims, as well as any structural detail that is essential for a proper understanding of the disclosed invention. Therefore, the input station arranged at the bath row end which is opposite to the end proximate to the output station, as recited in claim 1, and each of the three transport devices having a pair of cheeks, as recited in claim 3, as well as the toothed belts coupled to corresponding toothed belts via an additional toothed belt with appurtenant guide wheels and carriers at the other end of the cheeks, as recited in claim 5, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Examiner also notes that the drawings contain a number of inaccuracies. For example, reference number 6 is assigned to different elements (see Figures 1 and 4-5). Note that it is Applicant's responsibility to identify, locate and correct such errors.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Lines 1-6 of claim 1 recite a staining machine which includes "a number of baths placed successively in a row and a device for successive transport of the baskets in a transport path from one bath to the next one". The claim also states, in lines 7-15, that the machine includes "at least two bath rows placed juxtaposed and parallel with each other, the first bath row extending from the input station to an opposite end of the row, and a second bath row extending from the output station to an opposite end of the row, a first device for transport of baskets in a first transport path from the input station to the opposite end of the first row, a second device for transport of baskets in a second

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transport path towards the output station from the opposite end of the second row and a device for the transfer of baskets between the transport paths at opposite ends belonging together of the relevant rows". It is not clear whether the structure of lines 1-6 is re-defined in lines 7-15, and, if not, how the structure of lines 1-6 is inter-related with the structure of lines 7-15. Regarding the baskets being transported "in accordance with a predetermined treatment program", it is unclear whether or not any programmed controller is intended. Additionally, the claim does not set forth clear structural inter-relationships between the input / output stations and ends of each row. In this regard, the row "extending from the input station to an opposite end of the row", or the "path towards the output station from the opposite end of the second row", is unclear. Does it mean that the input station must be located at the end of the first row, other, than the "opposite" end of the first row, or that the output station must be located at the end of the second row, other, than the "opposite" end of the second row? How is the "opposite" end of the first row related to the "opposite" end of the second row? Further, the "transport paths at opposite ends belonging together of the relevant rows", is extremely unclear. See also claim 2 regarding the "two baths which are located next to each other at said opposite ends of the two rows".

With respect to claim 2, it is not clear whether or not the structure of the staining machine is re-defined once again, since the claim sets forth a staining machine which includes *only* a "first and a second bath row", and only one device for "transfer of baskets". The 'device for transfer of baskets' lacks antecedent basis.

In claim 3, the “bath row in question” lacks antecedent basis. The same applies to the “cheek pair” of line 5. Regarding the bath row being adapted for engagement with respective baskets, it is not clear whether or not any engagement means are intended.

In claim 4, the “stadium shaped movement” of the cheeks, is unclear.

Claim 5 recites the toothed belts coupled to corresponding toothed belts “via an additional toothed belt with appurtenant guide wheels and carriers at the other end of the cheeks”. The “corresponding toothed belts” lack antecedent basis. It is unclear whether the intended structure must include three or five toothed belts.

In claim 7, the “movement means” lack antecedent basis.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7 are rejected under 35 U.S.C. 102(b) as anticipated by Tabata (US 4911098).

With respect to claims 1-5, Tabata discloses an apparatus for staining tissue specimen slides comprising, as shown in Figures 6-7, one or two rows of baths 1-23 and at least two robots 21-22 [“devices for transport / transfer of baskets”]. Figure 7 illustrates a transport / transfer device configured for transferring baskets between the rows [“crossbar device”]. Each robot includes a clamp member 8 with a pair of plates 13

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["cheeks extending along the bath rows"] and a vertical driving mechanism including motor 27 ["device for lifting and lowering the cheek pair"] coupled to feed screw 26 via a belt [one of the two "toothed belts", not shown]. Figure 3 also shows the clamp member 8 having belt 15 [another "toothed belt" running "in a closed path"].

Regarding claims 6 and 7, the devices for transport / transfer of baskets can include, as is seen in Figures 7-8, a "crossbar bracket" 4 adapted for "releasable connection" with basket 2 and coupled to a means for reciprocating movement of the crossbar bracket in a horizontal direction, as indicated by the horizontal arrow in Figure 7. Figure 6 also shows the transport devices comprising feed screw 24 ["slide block"]. Note that the input / output stations, guide wheels and step motors (see claims 1-4 and 6-7), as well as the second pair of toothed belts coupled to the other end of each cheek, and the additional toothed belt (see claim 5), are, currently, not positively recited as a part of the claimed invention, and, therefore, they are not accorded any patentable weight.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalia Levkovich whose telephone number is 571-272-2462. The examiner can normally be reached on Mon-Fri, 2 p.m.-10 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797